

REMARKS

Claims 1, 3 and 8-13 are amended to correct informalities in the claim language and claim dependencies issues identified by the Examiner. No substantive amendments have been made to the claims. Upon entry of the amendment, claims 1-14 are presented for reconsideration to the Examiner in view of the following remarks.

Claims 9-13 are amended to correct claim dependency issues identified by the Examiner. Claims 9-13 now depend from claim 8. This amendment is believed to obviate any 35 U.S.C. §112 rejection of claims 9-14 properly made by the Examiner.

Claims 1 and 8 are amended to remove the word "wedge" before "pad" to address the 35 U.S.C. §112 rejection made by the Examiner.

The Examiner's §103 Rejection of Claims 1-3, 7-10 and 12 is Deficient

Claims 1-3, 7-10 and 12 were rejected by the Examiner under 35 U.S.C. § 103(a) as being obvious to one of skill in the art over a combination of U.S. Patent No. 2,191,834 to Slack (hereinafter Slack) in view of U.S. Patent No. 3,513,915 to Sherman (hereinafter Sherman). In making this rejection the Examiner notes that "Slack is silent regarding a central opening through said hoof and shoe surfaces and said tip is surrounded by said central opening toward said toe end and laterally relative to said line." Slack teaches an elastic horseshoe pad made of rubber or some similar composition" including an upwardly extending frog support 3 above a downwardly extending lug 4. The lug 4 and frog support 3 are intended to deliver force from ground contact upwardly to stimulate the frog in the horse's hoof. Slack teaches that this upward force delivery improves blood circulation and provides a spreading action to the hoof. It should be noted that the ground contact surface 5 of the downwardly projecting lug 4 traverses the rearward most portion of the support pad. Slack does not disclose, teach or suggest the need for a central opening through the body portion of the pad. In fact, Slack teaches that "the body portion includes one or more fabric layers to toughen the body and prevent premature breakage." (Slack, column 2, lines 11-16)

Sherman teaches a resiliently flexible horseshoe in combination with an elastomeric pad or sheet which defines a central opening for ventilation of the horse's

hoof. Sherman specifically teaches that "the tensile strength of the pad 11 is such that it will resist spreading of the buttresses of the horse's hoof in a manner which could otherwise injure the horse's hoof." (Sherman, column 2, lines 45-48). Sherman essentially teaches a shock absorbing pad and flexible shoe arrangement for the purpose of protecting horse's feet from shock, particularly, for horses used in racing, riding, rodeos and the like.

There is No Motivation to Combine the Teachings of Slack with the Teachings of Sherman

It is well established that there must be some motivation, either in the references themselves or in the knowledge of one of ordinary skill in the art, to combine the reference teachings to arrive at the claimed invention. See MPEP §2143.01. It is clearly impermissible to use the Applicant's specification and claims as a hindsight guide for the combination of references. Further, the fact that references can be combined or modified or that the claimed invention may be within the capabilities of one of skill in the art are not sufficient by themselves to establish *prima facie* obviousness. MPEP §2143.01.

There is no disclosure, teaching or suggestion in either Slack or Sherman that the configurations disclosed therein can or should be modified by reference to the other patent. The Examiner suggests that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a central opening as taught by Sherman in the support pad of Slack in order to allow ventilate [sic] the frog 16 in the horse's hoof.

Slack is obviously concerned with the structural integrity of its pad, teaching a reinforced rubber continuous sheet traversing the horse's hoof. There is no evidence presented by the Examiner or in the references that opening a hole surrounding the frog support in the horseshoe pad of Slack would not destroy the structural integrity with which Slack is so concerned. Further, Slack specifically teaches the inclusion of a wedge-formed frog support pad is intended to cause spreading of the foot "commencing at the quarters and gradually increasing to the heel portion of the foot."

(Slack, column 1, lines 30-33). Sherman, on the other hand, teaches a flexible horseshoe and pad where the pad is of a tensile strength that will resist spreading of the hoof. (Sherman, column 2, lines 45-48). The resiliently flexible horseshoe and pad combination of Sherman addresses a shock absorbing function distinct from the frog stimulation and spreading action addressed by the elastic horseshoe pad of Slack.

None of the References Cited by the Examiner Disclose, Teach or Suggest a Pad Including a Frog Support that is Open Forwardly and Laterally of the Frog Support Feature

The Examiner cites U.S. Patent Nos. 268,605; 460,459; 643,246; 2,191,834 (Slack) and 4,513,825 showing various frog support systems or protective pads incorporating a frog support. It is significant that none of these references disclose, teach or suggest that the pad be open forwardly and laterally of the frog support as required by claims 1 and 8.

Applicant Requests a Specific Identification of the Source of Motivation for the Examiner's Combination of the Teachings of Slack and Sherman

Since there is no support for the Examiner's proposed combination in the references themselves, Applicant respectfully requests that the Examiner identify the source of the motivation required to establish a *prima facie* case of obviousness. If the Examiner is relying on the knowledge of one of skill in the art, Applicant requests that the Examiner support that knowledge by citation to documentary support or make a statement taking "official notice" of facts supportive of the proposed combination. An unsupported statement that "it would have been obvious" to combine the reference teachings is clearly insufficient.

In sum, one of skill in the art in possession of the Slack and Sherman references would not attempt to combine the reference teachings to arrive at the claimed invention. Other than Applicant's specification and claims, there is no teaching in the art cited by the Examiner of the need for a frog stimulating horseshoe pad having the configurations and relationships recited in Applicant's claims 1 and 8.

Specifically, claim 1 recites in pertinent part:

a rounded tip of the frog support projecting toward said toe end from the heel end of the pad such that said tip is positioned in said central opening and centered on a line drawn from said toe end to said heel end to separate said support pad into equal lateral portions, wherein said tip is surrounded by said central opening toward said toe end and laterally relative to said line.

See claim 8, lines 7-12, 15 and 16 for similar limitations.

Neither Slack nor Sherman disclose, teach or suggest the claimed structures and relationships. As previously discussed, there is no motivation for one of skill in the art to combine the teachings of Slack with those of Sherman to arrive at Applicant's invention. The Examiner's proposed combination lacks support in the art as required by Patent Office procedure and legal precedent. The Examiner is prohibited from a hindsight reference to the Applicant's disclosure in making his proposed combinations. In sum, independent claims 1 and 8 are patentable over the combination of Slack with Sherman proposed by the Examiner.

Claims 2-7 depend directly or indirectly from claim 1 and are patentable for at least the reasons stated in support of claim 1.

Claims 9-14 depend directly or indirectly from claim 8 and are patentable for at least the reasons stated in support of claim 8.

Claim 3 recites in pertinent part "said ground contact face extends from said tip toward said heel end, said ground contact face terminating at least one inch from said heel end such that said shoe surface is continuous around the entire periphery of said support pad." The Examiner rejects claim 3 by again combining Slack with the teachings of Sherman. The Examiner acknowledges that Slack modified by Sherman is silent regarding inclusion of a continuous shoe surface around the periphery of the support pad. Applicant respectfully directs the Examiner's attention to the disclosed configuration of the horseshoe pad disclosed in Slack. The ground contact surface 5 exists only in the rearward most portion of the pad as shown in Figures 1 and 3. If this rearward most portion of the pad were removed in an attempt to have the pad of Slack conform with the recitations of claim 3, it would effectively destroy the functionality of the Slack pad. It is well established that an Examiner's proposed modification of a

reference cannot render the prior art unsatisfactory for its intended purpose. (MPEP § 2143.01). Thus, in addition to the previously discussed lack of motivation to combine and contrary purposes and teachings of the Slack and Sherman references, the Examiner's proposed modification of Slack essentially destroys its functionality. The Examiner has failed to present a *prima facie* case of obviousness with respect to claim 3. Claim 3 is patentable for at least this additional reason.

Rejection of Claim 9

The Examiner rejects claim 9 with an unsupported statement that the Slack/Sherman combination (emphasis on Slack) teaches use of the horseshoe types recited in claim 9. Clearly, the pad of Slack is incompatible with eggbar or straight bar horseshoes given that the downwardly projecting lug 4 of Slack occupies the rearward portion of the hoof area where the bar (either egg or straight) would be required to traverse the hoof. Further, bar-type shoes are known in the art to resist spreading of the hoof while one stated function of the Slack pad is to promote spreading of the hoof. Claim 9 is patentable over the cited references for at least these additional reasons.

The Examiner's 35 U.S.C. §103(a) Rejection of Claims 4-6, 11, 13, and 14 Inherits the Flaws of the Proposed Combination of Slack with Sherman

Claims 4-6, 11, 13 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Slack as modified by Sherman, further in view of U.S. Patent No. 4,513,825 to Murphy (hereinafter Murphy). Murphy discloses a horseshoe full pad to be interposed between a metal horseshoe and the hoof made of an energy absorbing micro-cellular urethane foam having a tough outer skin. The pad is characterized by having a central layer or sheet which covers the bottom of and can be trimmed to fit the circumference of the hoof. Murphy discloses that a frog pad may be molded into the hoof side of the pad to further protect and/or stimulate the frog. Murphy does not disclose, teach or suggest an open center and, in fact, discloses stabilizer bars and shock reducers molded into the turf side of the pad which rise to about the level of the horseshoe.

It should be noted that with respect to the claims 4-6, 11, 13 and 14, these claims depend directly or indirectly from claim 1 or claim 8 and are patentable for at

least the reasons stated previously in support of claims 1 and 8. This rejection of claims 4-6, 11, 13 and 14 inherits all of the deficiencies of the Slack/Sherman combination discussed in greater detail above with respect to claims 1 and 8. Thus, this rejection is built on a fundamentally flawed combination of the teachings of the Sherman and Slack references. The horseshoe full pad of Murphy is also incompatible with the teachings of Sherman for many of the same reasons that Slack is compatible with Sherman. Murphy teaches a full pad and does not disclose, teach or suggest a pad with an opening in the middle. Thus, one of skill in the art would not attempt to combine the teachings of Murphy with those of Sherman.

For all the foregoing reasons, Applicant respectfully requests allowance of claims 1-14.

Respectfully submitted,
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